

REMARKS



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In the Office Action dated July 17, 2000, claims 6-20 have been withdrawn from consideration. Claims 1-5 are rejected under 35 U.S.C. §112, first paragraph as allegedly not enabled. Claims 1 and 4-5 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 5,789,201.

In response to the above rejections, Applicants have amended the claims which, when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration of all pending claims is respectfully requested.

In the Office Action, the Examiner has made the restriction requirement final and has withdrawn claims 6-20 from consideration.

It is respectfully submitted that claims 6-20 have been canceled without prejudice by way of the instant amendment. Applicants reserve the right to pursue the subject matter of these canceled claims in a divisional application.

Claims 1-5 are rejected under 35 U.S.C. §112, first paragraph. The Examiner admits that the specification is enabling for an isolated nucleic acid molecule comprising SEQ ID NO: 6 or 8 which encodes the amino acid sequence of SEQ ID NO: 7 or 9. However, the Examiner contends that the specification does not provide enablement for all nucleic acid molecules encompassed by the claims. The Examiner states that the specification does not disclose any derivative of SEQ ID NO: 6 or 8, or a nucleic acid molecule encoding an amino acid sequence having at least 47% similarity to SEQ ID NO: 7 or 9, or a nucleic acid molecule which hybridizes under low stringency conditions to SEQ ID NO: 6 or 8 and which elicits a Bcl-w-related activity. It is the Examiner's opinion that it would take undue experimentation for those skilled in the art to practice the claimed invention.



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Applicants respectfully submit that claims 1-5 have been amended. More specifically, claim 1 as amended is directed to an isolated nucleic acid molecule encoding a protein which enhances cell survival, wherein said protein has a sequence of SEQ ID NO:7 (human Bcl-w), SEQ ID NO:9 (murine Bcl-w), or a sequence having at least about 47% similarity to SEQ ID NO:7 or SEQ ID NO:9, or a derivative of SEQ ID NO: 7 or SEQ ID NO: 9.

Claims 2-4 as amended depend from claim 1. Claim 2 is directed to an isolated nucleic molecule encoding the amino acid sequence set forth in SEQ ID NO: 7 or SEQ ID NO: 9. Claim 3 is directed to an isolated nucleic acid molecule comprising SEQ ID NO: 6 or SEQ ID NO: 8. Claim 4 is directed to an isolated nucleic acid molecule which hybridizes under low stringency conditions to SEQ ID NO: 6 or SEQ ID NO: 8. Claim 5 has been canceled; and the subject matter of original claim 5 is further delineated in claims 1-4.

2 It is respectfully submitted that the nucleic acid molecules of claims 1-4 as amended do not include all derivatives or sequences that share sequence similarities to SEQ ID NO: 6 or 8, but include those derivative and homologous sequences that enhance cell survival. Applicants respectfully submit that the present specification adequately teaches the molecules as claimed. For example, the specification teaches the isolation of the human bcl-w gene (SEQ ID NO: 6) and the murine bcl-w gene (SEQ ID NO: 8). The specification also shows that the human Bcl-w protein and the murine Bcl-w share about 90% similarity. Moreover, the specification provides specific exemplification demonstrating that expression of the bcl-w gene enhances cell survival. See pages 35-36 of the specification. In light of the present teaching, those skilled in the art can isolate a nucleic acid molecule that either hybridizes to SEQ ID NO: 6 or 8, or encodes a protein that shares at least about 47% similarity to SEQ ID NO: 7 or 9, and determine whether the isolated molecule enhances cell survival. It is respectfully submitted that the experimentation



required for those skilled in the art to make and use the claimed molecule is not undue.

Accordingly, the rejection of claims 1-5 under 35 U.S.C. §112, first paragraph is overcome.

Withdrawal of the rejection is respectfully requested.

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Claims 1 and 4-5 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 5,789,201 ("the '201 patent"). According to the Examiner, the '201 patent teaches nucleotide sequences encoding a bcl-2 homolog (bcl-y). It appears from the sequence search report provided by the Examiner that the human bcl-y gene of the '201 patent matches 97.4% to instant SEQ ID NO: 6 (human bcl-w), and 85% to instant SEQ ID NO: 8 (murine bcl-w); and that the human Bcl-y protein of the '201 patent matches 98.7% to instant SEQ ID NO: 7 (human Bcl-w).

I It is respectfully submitted that the present inventors reduced the claimed invention to practice in Australia (a WTO member) prior to January 1, 1996. As evidence of the prior reduction of the invention, Applicants provide herewith photocopies of the sequences entered into the mainframe computer at the Walter and Eliza Hal Institute prior to January 1, 1996: human bcl-w nucleotide sequence (Exhibit A, wherein the coding region is underlined), and murine bcl-w nucleotide (Exhibit B, wherein the coding region is underlined). The dates of entry of these sequences into the computer have been masked before the preparation of these photocopies. Applicants will provide a §1.131 declaration from the present inventors attesting to the prior date of invention as soon as the inventors become available.

X In accordance with the provisions of 37 C.F.R. §1.131, Applicants are entitled to a date of completion of the present invention at least as early as January 1, 1996, i.e., prior to the reference date of the '201 patent (February 11, 1997), and prior to the filing date (February 23, 1996) of Application Serial No. 60/012,201, based on which the '201 patent claims benefit. Thus,

Applicants respectfully submit that the '201 patent is not prior art in respect to the present application. Accordingly, the rejection under 35 U.S.C. §102(e) based on the '201 patent is overcome. Withdrawal of the rejection is therefore respectfully requested.



In view of the foregoing amendments and remarks, it is firmly believed that the subject application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Frank S. DiGiglio".

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